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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,609	12/28/2000	Marc Traylor	D-6904	8543

26375 7590 10/15/2002

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EXAMINER

SZUMNY, JONATHON A

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 10/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<p style="text-align: center;"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p>09/751,609</p>	<p><b>Applicant(s)</b></p> <p>TRAYLOR, MARC</p>	
	<p><b>Examiner</b></p> <p>Jon A Szumny</p>	<p><b>Art Unit</b></p> <p>3632</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2002.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 03 June 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>8</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other:   |

Art Unit: 3632

This is the third office action for application number 09/751,609, Resilient Magnetic Paintbrush Holder, filed on December 28, 2000.

Finality of the previous office action has been withdrawn.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagy '158.

With respect to claims 1, 4, 7, 11-14, 18 and 19, Nagy '158 discloses a holder (figure 1) comprising a clamp (28, 30, 32, 33 and 34, figure 1), a magnet (48, figure 1), a magnet holder (40, 42, 44 and 46, figure 1) and a resilient member/length of resilient material/spring (figure 1) having a proximal portion (figure 1) attached to the clamp and a distal portion (figure 1) attached to the magnet; wherein the resilient member (24), the magnet holder (46) and at least a portion of the clamp (28, 30, 32, figure 2) constitute a single molded structure; wherein the holder further comprises a paint can (6) and a paintbrush (10); wherein the resilient member (24) inherently has a force constant which may be selected to produce some displacement of the distal portion when subjected to a shock without causing failure of the resilient member (24) beyond its inherent elastic

limit. In regards to claims 2, 5, 8 and 15, the member inherently acts as a spring whenever a force is applied perpendicularly to it. In regards to claims 3, 6, 9, 16, member 24 is inherently resilient due to the material it is made from.

Regarding claims 10, 17 and 20, Nagy '158 fails to specifically teach the resilient member to limit acceleration of an object attached thereto to no more than 0.75 g. It would have been obvious to an ordinary artisan at the time the invention was made that any one of number of resilient members that each limit the acceleration of an object attached thereto to a different degree could be selected, including no more than 0.75 g, in order to meet a user's design preferences or the specific dimensions of an object attached to the resilient member, so long as the integrity of the holder is not compromised. Moreover, there appears to be no unexpected result stemming from the 0.75g recitation.

### ***Response to Arguments***

Applicant's arguments filed September 16, 2002 have been fully considered but they are not persuasive.

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection. However, the Examiner will address all other remaining issues.

On page 10 of the remarks, the applicant alleges that there is no teaching that the "flat faced metal strap" of Nagy '158 has a force constant selected to produce a displacement of the distal portion when the paintbrush is subjected to a mechanical

Art Unit: 3632

shock so that the paintbrush does not slide off the magnet. While there is no specific teaching in the written specification of such a force constant, it is in the inherent nature of bendable/resilient metal to have some force constant, and whether or not the force constant was selected to produce a displacement of the distal portion when subjected to a mechanical shock would be a user preference or a design choice.

Regarding the applicant's allegation that Nagy '158 fails to teach the resilient member, the magnet holder and at least a portion of the clamp to comprise a single molded structure, the Examiner disagrees. As indicated on the previously attached copy of figure 1 of Nagy '158, the magnet holder (indicated by the Examiner) clearly assists in "holding" the magnet in place, since without such, the magnet could possibly become disengaged from the paintbrush holder, and hence, the resilient member, magnet holder, and at least a portion of the clamp do in fact comprise a single molded structure.

Further, on page 12 of the remarks, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, one of ordinary skill in the art could clearly select a resilient member having any one of myriad force constants that would limit

acceleration of the paintbrush to various accelerations, including no more than 0.75g, and such a selection would depend upon a user preference or specific design choice. Hence, selecting a force constant that limits acceleration of the paintbrush to no more than 0.75g is not considered patentable.

Moreover, the Examiner's reason for modifying the resilient member of Nagy '158 to limit acceleration of the paintbrush to no more than 0.75g was not simply to "not compromise the integrity of the paintbrush holder," as alleged by the applicant. The Examiner specifically mentioned the reason as being "to meet a user's design preferences or the specific dimensions of an object attached to the resilient member, so long as the integrity of the holder is not compromised."

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Speckhart '729, Jackson '623, Stelmach '887 and Schneider et al. '999 divulge various holders.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon A Szumny whose telephone number is (703) 306-3403. The examiner can normally be reached on Monday-Friday 8-4.

The fax phone number for the organization where this application and proceeding are assigned is (703) 305-7687.

Art Unit: 3632

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Jon Szumny  
Patent Examiner  
Technology Center 3600  
Art Unit 3632  
October 8, 2002

LESLIE A. BRAUN  
SUPERVISORY PATENT EXAMINER